

Appl. No 09/990,326
Amdt. dated Nov. 11, 2004
Reply to Advisory Action dated July 12, 2004

REMARKS

Claims 40 and 41 now stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 40 has been amended to refer to a reflective panel only and reconsideration is requested.

Claims 1, 4-7, 12, 13, 15, 21, 22, 27, 31, 34-36, 39 and 42 now stand rejected under 35 U.S.C. 102(b), as being anticipated by Giuliano et al.

Claims 2, 3, 8, 9, 14, 16, 23-26, 28, 32, 33, 37, 38, 40, 41 and 43 now stand rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al in view of Ming-ho, Lee, Volland, Day et al., and Oda et al.

Referring now to United States Patent 5,743,616 to Giuliano hereinafter referred to as '616 there is taught an image display of one or more thin integrated panels having an LED embedded in the edge thereof and including an image being scratched or etched with a display. As taught at Column 2 of the disclosure of the '616 patent the panels are thin and the overall display may include coloured LED's or translucent panels. **However, at no time does the '616 patent to Giuliano teach an ornament,** or motivate one skilled in the art to do so. The present amendment of Claim 1-7, 12-16, 21-28, 31-33, 36-38 and 42 have been limited to a **decorative** ornament only. It is submitted according to accepted jurisprudence that for reference to anticipate it must describe each and every element of the invention. In this regard see In Re: Donahue previously cited. Exclusion of claimed elements from a prior art reference is enough to negate anticipation by that reference. It is therefore respectfully submitted that the above-mentioned list of claims specifically referring to an ornament are not anticipated by the '616 reference.

The Examiner alleges that Giuliano United States Patent 5,743,616 teaches an ornament. This issue is refuted with a last response. However the Examiner has maintained her allegation that Giuliano teaches an ornament. The entire document has been carefully scrutinized and reviewed electronically to determine whether any reference to ornamentation

Appl. No 09/990,326
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is present in the '616 Giuliano reference. The teaching of a decorative ornament is clearly lacking from '616.

An ornament is described as follows in the respective references:

Concise Oxford English Dictionary

- An object designed to add beauty to something.

The Houghton Mifflin Canadian Dictionary of the English Language

- Anything that decorates or adorns; an embellishment.

Clearly the sign of Giuliano the '616 Patent cannot be considered to be an ornament within the definition of Applicant's claims since there is no teaching with respect to the use of the sign of '616 as an ornament or that would include any decorative aspects that is to say something beyond the functionality of the teachings of the reference, the '616 Patent including the examples therein is entirely functional. Other than a general allegation that it is an ornament by the Examiner she does not point to any teaching within the reference itself that would clearly suggest directly or indirectly that the teachings of the reference might be used to prepare an ornament. Applicant's agent has scanned the reference into searchable form and has reviewed it entirely both manually and electronically and has not found any teaching to support such an erroneous supposition by the Examiner. This is clearly another indication that the Examiner is using 20/20 hindsight in preparing her refusal of the application. As previously stated and as required by Donahue contained with Applicant's prior response to which the Examiner is referred and which response is incorporated by reference in full, that it is sufficient for a reference such as Giuliano to be refused as destroying a novelty of the claims at issue if it lacks one element of the claimed invention. Applicant therefore has included in its claims with respect to ornaments the further explanation that the ornament is a decorative ornament more completely and full reconsideration of said claim set is respectfully requested.

Appl. No 09/990,326
Amdt. dated Nov. 11, 2004
Reply to Advisory Action dated July 12, 2004

Further it is surmised that the Examiner may allege an obviousness rejection on the same grounds. However for any surmised obviousness rejection Graham and John Deere, must be referred to and one would conclude that there is significant difference between the '616 reference and the claims at issue since '616 reference does not directly teach nor infer the combination of the claimed elements described in the above-mentioned list of claims for a decorative ornament. Further there is no motivation within the '616 reference to manufacture an ornament from the teachings of '616. There is no reason, suggestion or motivation found in the '616 reference whereby a person of ordinary skilled in the art would arrive at the invention of a decorative ornament. To do so following the Examiner's arguments and allegations would require 20/20 hindsight which is not permissible. For example, In Re: Fritch it was held impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Examiner therefore has failed in setting forth her prima facie case of obviousness as a result of her improper interpretation of the teaching of Giuliano. It is also noted that Giuliano is classified in class 362/31 related to illumination while Applicants invention is classified in class 40/544 related to ornamentation.

Applicant therefore had previously amended the claims set to include limitations not found in the '616 reference. Clearly all of the Examiner's rejections are based on the misinterpretation of the Giuliano reference. Any combination of her alleged primary reference with any other reference therefore cannot arrive at applicant's teaching whether combined with Ming-ho, Lee, Volland, Day et al., and Oda et al. It is submitted that the '616 reference does not teach the limitations found in Applicant's amended claim set.

With regard to the Examiner's obviousness rejections with respect to the '616 reference as a primary reference it is respectfully submitted that all the claims have now been amended to identify over the '616 reference and any combination that the Examiner may put forward with respect to various patents cited on page 9 of her report namely in view of any or all of Ming-ho, Lee, Volland, Day et al., and Oda et al. The primary reference fails to teach a decorative ornament and there is no motivation in Giuliano to combine with the teachings of the art Ming-ho, Lee, Volland, Day et al., and Oda et al and arrive at Applicant's invention. Clearly, '616 cannot be strung together with like items and therefore cannot be considered an

Appl. No 09/990,326
 Amdt. dated Nov. 11, 2004
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ornament. Clearly, the prior art does not suggest or provide any reason or motivation to make such a modification as purported by the Examiner. With reference to In Re: Regal, 526 F. 2d 1399, 1403 n. 6, 188 USPQ 136, 139 n. 6 (CCPA 1975).

"There must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references".

In Re: Geiger, 815 F. 2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987) (obviousness can not be established by combining pieces of prior art absence some "teachings, suggestion, or incentive supporting the combination"): In Re: Cho, 813 F. 2d 378, 382, 1 USPQ 2d 1662, 1664 (Fed. Cir. 1987) ("discussing the Board's holding that the artisan would have been motivated to combine the references").

For example, the Examiner has alleged that Claims 2 and 3 are obvious in view of '616 and Ming Ho stating that Ming Ho at column 14 teaches displays of Santa Claus, crucifix or a heart. If the Examiner will read that particular section specified in Ming Ho there is clearly no reference to Santa Claus, crucifix or hearts at specific lines 37 to 53. What is stated is toys, gift items, decorations, pins, buttons, badges, ornaments and the like. It is respectfully submitted then that Ming Ho does not teach Christmas ornaments as in required in Claim 2 nor Santa Claus, crucifix or a heart as required by Claim 3. Further it is submitted that when reading the '616 reference one skilled in the art would not apply the teachings or combine the teachings of the Ming Ho reference since the teachings thereof are not readily combinable. Ming Ho teaches greeting cards and plaques which are flat and planer. The lighting thereof is internal and there is no possibility of combining that with the lighting of the '616 reference.

Referring now to Voland, U. S. 4,965,701, there is nothing within the teachings of Voland that would teach a string of ornaments. Clearly Voland teaches a curtain kit wherein the curtain is suspended as a series of parallel light ropes (which light as well) as seen in Figure 3 including a string of lights extending on an optical fibre from a horizontal member in Figure 8 utilized as illumination for divider curtains for the interior of a dwelling. The teachings of Voland include a supporting member which the strings of the light members extend from. Clearly an illumination curtain kit including bulbs is not the

Appl. No 09/990,326
Amdt. dated Nov. 11, 2004
Reply to Advisory Action dated July 12, 2004

same things as an ornament. One skilled in the art of manufacturing holiday ornaments would not look to the teachings of this reference to curtains to separate two rooms, for example, in a dwelling. Therefore this reference cannot be readily combined with the '616 to arrive at the teachings of Claims 16, 23, 24, 28 and 32 now amended. It is submitted that the dependant claims include the limitations of the independent claims from which they depend and these are clearly not taught in the Voland reference or any combination of the '616 and Voland reference. How therefore might a conclusion of obviousness be arrived at? The '616 structure will also not readily combine with Voland.

The Examiner continues her 20/20 hindsight reconstruction by attempting to combine '616 with Ming Ho with respect to illuminated toys and again Claim 43 as well.

Respectively the Examiner is clearly picking and choosing elements from the prior art in creating a 20/20 hindsight reconstruction. This is not permitted and in fact with the additional case law cited in this response in Re: Fritch it is not permissible to use the claimed invention as an instruction manual or template to piece together the teachings of prior art so that the claimed invention is rendered obvious. This is a 20/20 hindsight construction and the efforts of the Examiner to do so are clear. Picking and choosing references from the prior art and combining it with a reference that does not teach for example ornaments nor Applicant's invention as specified in the amended claims is not permissible.

As specified in Re: Rouffet the court requires the Examiner to show a motivation to combine the references to create the case of obviousness. The Examiner must show reasons that the skilled artisan confronted with the same problem as the Applicant with no knowledge of the claimed invention would select the elements from the cited prior art references for combination in the matter claimed.

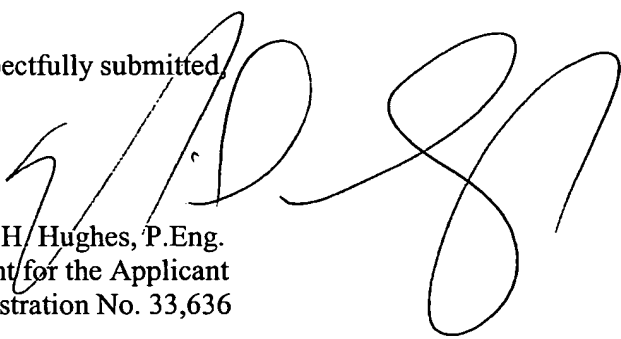
It is therefore requested that the Examiner withdraw her obviousness rejection of the claims indicated in her report and that full reconsideration be given to the amended claim set in view of those amendments and the arguments presented above.

Appl. No 09/990,326
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Applicant had previously samples of decorative ornaments embodying the invention which are clearly distinguishable from the display signs of Giuliano; one skilled in the art not confusing the two constructions, Giuliano being entirely functional and the samples being primarily decorative. The samples, which provide only one aspect of the invention, show that the light source is contained in the ornament embodied in the shape of a star and having a translucent outer surface. If the Examiner will plug in the sample she can note the diffusion of the light the samples therefore clearly achieving one of the objects of the invention. She will also note that the sample is robust and of a considerable advance over the art of for example Christmas lights. Please note that the sample was prepared for the Examiner specifically and that the ornaments for production purposes would be structured to include ornaments more closely resembling the loose samples provided in a separate bag. These samples show the ornament formed with respect to figures 10 and 18, and 19 to include a raw diode. The Examiner is referred to those portions and descriptions related thereto which are incorporated by reference herein.

If the Examiner has any questions, the Examiner is respectfully requested to contact Neil H. Hughes at (905) 771-6414 at her convenience.

Respectfully submitted,



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Enclosures